



PATENT

**IN THE UNITED STATES**  
**PATENT AND TRADEMARK OFFICE**

**Title:** "System and Technique for Automatically Associating Related Advertisements to Individual Search Results Items of a Search Result Set" **#9**

**Applicants:** Emens et al.

**Attorney Docket No.:** AM9-99-0118

**Serial No.:** 09/583,516

**Examiner:** Raquel Alvarez

**Filed:** May 31, 2000

**Art Unit:** 3622

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**APPEAL BRIEF**

Dear Sir:

10 This appeal brief is submitted under 35 U.S.C. §134. This appeal is further to Appellants' Notice of Appeal filed February 3, 2004.

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**(1) Real Party in Interest**

The real party in interest is International Business Machines Corporation.

**(2) Related Appeals / Interferences**

No other appeals or interferences exist that relate to the present application or appeal.

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**(3) Status of Claims**

Claims 1-3, 5-23, and 25-37 are pending and remain in the application. By the Final Office Action dated December 3, 2003, the Examiner (1) has rejected claims 1-3, 5-12, 15-20, 22-29, and 31-36 under 35 U.S.C. § 102(b) as being anticipated by Skillen et al. WO 98/36366 (hereinafter "Skillen") and (2) has rejected claims 13, 14, 21, 30, and 37 under 35 U.S.C. § 103(a) as being unpatentable over Skillen. All of the pending claims and all of the rejections are hereby appealed. A copy of the appealed claims is enclosed herewith as Appendix A.

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**(4) Status of Amendments**

No amendments are outstanding.

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**(5) Summary of Invention**

The present invention relates to a system and technique of targeting *at least one* associated advertisement from an Internet search having access to an information repository by a user, including (1) *identifying* at least one *search result item* from a search result of the Internet search by the user, (2) searching for the *at least one* associated advertisement within said repository using the at least one *search result item*, (3) identifying the *at least one* associated advertisement from the repository having *at least one* word that matches the at least one *search result item*, and (4) correlating the *at least one* associated advertisement with *the at least one search result item*.

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**(6) Issues Presented for Review**

The issues for review are (1) whether claims 1-3, 5-12, 15-20, 22-29, and 31-36 are unpatentable under 35 U.S.C. § 102(b) as being anticipated by Skillen and (2) whether claims 13, 14, 21, 30, and 37 are unpatentable under 35 U.S.C. § 103(a) as being obvious over Skillen.

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**(7) Grouping of Claims**

Claims 1-3 and 5-15 are grouped together and stand and fall together.

Claims 16-21 are grouped together and stand and fall together.

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Claims 22-23 and 25 are grouped together and stand and fall together.

Claims 26-30 are grouped together and stand and fall together.

Claims 32 and 33 are grouped together and stand and fall together.

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Claims 35-37 are grouped together and stand and fall together.

**(8) Arguments**

**A. Introduction**

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The issues for review are (1) whether claims 1-3, 5-12, 15-20, 22-29, and 31-36 are unpatentable under 35 U.S.C. § 102(b) as being anticipated by Skillen and (2) whether claims 13, 14, 21, 30, and 37 are unpatentable under 35 U.S.C. § 103(a) as being obvious over Skillen.

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**B. Whether claims 1-3, 5-12, 15-20, 22-29, and 31-36 are unpatentable under 35 U.S.C. § 102(b) as being anticipated by Skillen**

Applicants respectfully traverse the anticipation rejection of claims 1-3, 5-12, 15-20, 22-29, and 31-36, and submit that claims 1-3, 5-12, 15-20, 22-29, and 31-36 are not anticipated by Skillen, and are patentable thereover. In support of this position, Applicants submit the following arguments:

**1. Legal Standard for Lack of Novelty (Anticipation)**

The standard for lack of novelty, that is, for "anticipation," is one of strict identity. To anticipate a claim for a patent, a single prior source must contain all its essential elements, and the burden of proving such anticipation is on the party making such assertion of anticipation. Anticipation cannot be shown by combining more than one reference to show the elements of the claimed invention. The amount of newness and usefulness need only be minuscule to avoid a finding of lack of novelty.

The following are two court opinions in support of Applicants' position of non anticipation, with emphasis added for clarity purposes:

- "Anticipation under Section 102 can be found only if a reference shows **exactly** what is claimed; where there are **differences** between the reference disclosures and the claim, a rejection must be based on obviousness under Section 103." *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985).
- "**Absence** from a cited reference **of any element** of a claim of a patent negates anticipation of that claim by the reference." *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986), on rehearing, 231 USPQ 160 (Fed. Cir. 1986).

**2. Application of the Anticipation Standard to the Present Invention**

By the Final Office Action dated December 3, 2003, the Examiner has rejected claims 1-3, 5-12, 15-20, 22-29, and 31-36 under 35 U.S.C. § 102(b) as being anticipated by Skillen et al. WO 98/36366 (hereinafter "Skillen"). In order to be an anticipation of a claim under 35

U.S.C. § 102(b), a reference must teach every element of the claim, including the relationships between the elements. If any element is not fully taught by the reference, the rejection cannot be sustained.

Evaluating Skillen in this light, it is appropriate to examine the portions of Skillen which the Examiner has pointed to as teaching the claimed elements.

**Claims 1-3, 5-12, 15, 22, 23, and 25**

**Claim 1**

To the extent the Examiner's language at page 3 of the Office Action can be understood, it appears that the Examiner has asserted the following correspondence between Skillen and claim 1, as amended:

<b><u>Claim 1</u></b>	<b><u>Skillen</u></b>
A method of targeting <i>at least one</i> associated advertisement from an Internet search having access to an information repository by a user, comprising: <i>identifying</i> at least one <i>search result item</i> from a search result of said Internet search by said user; searching for said <i>at least one</i> associated advertisement within said repository using said at least one <i>search result item</i> ; identifying said <i>at least one</i> associated advertisement from said repository having <i>at least one</i> a word that matches said at least one <i>search result item</i> ; and correlating said <i>at least one</i> associated advertisement with <i>said at least</i>	-  -  <u>Skillen</u> does not teach this claim element.   <u>Skillen</u> does not teach this claim element.   <u>Skillen</u> does not teach this claim element.

one search result item.	
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In reviewing the cited portions of Skillen, however, it becomes apparent that Skillen has been generalized, and, in fact, does not support the position asserted by the Examiner. With regard to claim 1, Skillen fails to teach “searching for said *at least one* associated advertisement within said repository using said at least one *search result item*”, as required by claim 1. Instead, Skillen teaches away from this claim element by teaching “[looking] for a match in the product database 42 [by] determining a logical product fit to the initial search argument”, where the initial search argument is not the “at least one *search result item*” required in claim 1. (See Skillen, page 9, line 37 and page 10, lines 1-11.) Skillen teaches uses the same search argument for an Internet search for a search of a product database. (See Skillen, page 9, line 37 and page 10, lines 1-11.) In contrast, claim 1 uses the result of an Internet search, the “at least one *search result item*”, as an input to a search of a repository of advertisements. Thus, Skillen cannot teach this element of claim 1.

For similar reasons, Skillen cannot teach “identifying said *at least one* associated advertisement from said repository having *at least one* word that matches said at least one *search result item*” and cannot teach “correlating said *at least one* associated advertisement with said *at least one search result item*”, as required by claim 1. It is therefore clear that Skillen cannot teach each element of claim 1 and, therefore, a rejection of claim 1 under 35 U.S.C. § 102(b) is inappropriate.

#### Claims 2, 3, 5-12, and 15

Since dependent claims 2, 3, 5, and 6 depend on independent claim 1 and since Skillen cannot teach each element of claim 1, Skillen also cannot teach each element of claims 2, 3, 5, and 6, and therefore, a rejection of claims 2, 3, 5, and 6 under 35 U.S.C. § 102(b) is inappropriate. Since dependent claims 7-12 depend on claim 6 and since Skillen cannot teach each element of claim 6, Skillen also cannot teach each element of claims 7-12, and therefore, a rejection of claims 7-12 under 35 U.S.C. § 102(b) is inappropriate. Since dependent claim 15 depends on claim 8 and since Skillen cannot teach each element of claim

one search result item.	
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In reviewing the cited portions of Skillen, however, it becomes apparent that Skillen has been generalized, and, in fact, does not support the position asserted by the Examiner. With regard to claim 1, Skillen fails to teach “searching for said *at least one* associated advertisement within said repository using said at least one *search result item*”, as required by claim 1. Instead, Skillen teaches away from this claim element by teaching “[looking] for a match in the product database 42 [by] determining a logical product fit to the initial search argument”, where the initial search argument is not the “at least one *search result item*” required in claim 1. (See Skillen, page 9, line 37 and page 10, lines 1-11.) Skillen teaches uses the same search argument for an Internet search for a search of a product database. (See Skillen, page 9, line 37 and page 10, lines 1-11.) In contrast, claim 1 uses the result of an Internet search, the “at least one *search result item*”, as an input to a search of a repository of advertisements. Thus, Skillen cannot teach this element of claim 1.

For similar reasons, Skillen cannot teach “identifying said *at least one* associated advertisement from said repository having *at least one* a word that matches said at least one *search result item*” and cannot teach “correlating said *at least one* associated advertisement with said *at least one search result item*”, as required by claim 1. It is therefore clear that Skillen cannot teach each element of claim 1 and, therefore, a rejection of claim 1 under 35 U.S.C. § 102(b) is inappropriate.

#### Claims 2, 3, 5-12, and 15

Since dependent claims 2, 3, 5, and 6 depend on independent claim 1 and since Skillen cannot teach each element of claim 1, Skillen also cannot teach each element of claims 2, 3, 5, and 6, and therefore, a rejection of claims 2, 3, 5, and 6 under 35 U.S.C. § 102(b) is inappropriate. Since dependent claims 7-12 depend on claim 6 and since Skillen cannot teach each element of claim 6, Skillen also cannot teach each element of claims 7-12, and therefore, a rejection of claims 7-12 under 35 U.S.C. § 102(b) is inappropriate. Since dependent claim 15 depends on claim 8 and since Skillen cannot teach each element of claim

8, Skillen also cannot teach each element of claim 15, and therefore, a rejection of claim 15 under 35 U.S.C. § 102(b) is inappropriate.

**Claim 22**

5 Since claim 22 is the program storage device version of claim 1 with the same elements as claim 1 and since Skillen cannot teach each element of claim 1, Skillen also cannot teach each element of claim 22, and therefore, a rejection of claim 22 under 35 U.S.C. § 102(b) is inappropriate.

**Claims 23 and 25**

10 Since dependent claims 23 and 25 depend on independent claim 22 and since Skillen cannot teach each element of claim 22, Skillen also cannot teach each element of claims 23 and 25, and therefore, a rejection of claims 23 and 25 under 35 U.S.C. § 102(b) is inappropriate.

**Claims 16-20, 26-29, 31, 35, and 36**

**Claim 16**

15 To the extent the Examiner's language at page 4 of the Office Action can be understood, it appears that the Examiner has asserted the following correspondence between Skillen and claim 16:

<b>Claim 16</b>	<b><u>Skillen</u></b>
A method for providing related advertisements for search result items from a search of an information repository, comprising: matching said <i>search result</i> items to said related advertisements; designating each of said <i>search result</i> items that have said related advertisements matched therewith; providing a corresponding graphical user interface for each of said	-  <u>Skillen</u> does not teach this claim element.  <u>Skillen</u> does not teach this claim element.  <u>Skillen</u> does not teach this claim element.  <u>Skillen</u> does not teach this claim element.



<p><i>search result</i> items so designated for subsequent user selection;</p> <p>searching and retrieving said related advertisements for one of said <i>search result</i> items when said corresponding graphical user interface is selected by a user; and,</p> <p>formatting and displaying said related advertisements upon selection.</p>	-
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In reviewing the cited portions of Skillen, however, it becomes apparent that Skillen has been generalized, and, in fact, does not support the position asserted by the Examiner. With regard to claim 16, Skillen fails to teach “matching said *search result* items to said related advertisements”, as required by claim 16. Instead, Skillen teaches away from this claim element by teaching “[looking] for a match in the product database 42 [by] determining a logical product fit to the initial search argument”, where the initial search argument is not the “*search result* items” required in claim 16. (See Skillen, page 9, lines 14-37 and page 10, lines 1-13.) Skillen teaches uses the same search argument for an Internet search for a search of a product database. (See Skillen, page 9, lines 14-37 and page 10, lines 1-13.) In contrast, claim 16 uses the results of an Internet search, the “*search result* items”, as inputs to a search of a repository of advertisements. Thus, Skillen cannot teach this element of claim 16.

For similar reasons, Skillen cannot teach “designating each of said *search result* items that have said related advertisements matched therewith”, cannot teach “providing a corresponding graphical user interface for each of said *search result* items so designated for subsequent user selection”, and cannot teach “searching and retrieving said related advertisements for one of said *search result* items when said corresponding graphical user interface is selected by a user”, as required by claim 16. It is therefore clear that Skillen cannot teach each element of claim 16 and, therefore, a rejection of claim 16 under 35 U.S.C. § 102(b) is inappropriate.

**Claims 17-20**

Since dependent claims 17-20 depend on independent claim 16 and since Skillen cannot teach each element of claim 16, Skillen also cannot teach each element of claims 17-20, and therefore, a rejection of claims 17-20 under 35 U.S.C. § 102(b) is inappropriate.

5

**Claim 26**

Skillen also cannot teach each element of claim 26 for reasons similar to the reasons why Skillen cannot teach each element of claim 16 and, therefore, a rejection of claim 26 under 35 U.S.C. § 102(b) is inappropriate.

**Claims 27-29**

10

Since dependent claims 27-29 depend on independent claim 26 and since Skillen cannot teach each element of claim 26, Skillen also cannot teach each element of claims 27-29, and therefore, a rejection of claims 27-29 under 35 U.S.C. § 102(b) is inappropriate.

**Claim 31**

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Since claim 31 is the program storage device version of claim 16 with the same elements as claim 16 and since Skillen cannot teach each element of claim 16, Skillen also cannot teach each element of claim 31, and therefore, a rejection of claim 31 under 35 U.S.C. § 102(b) is inappropriate.

**Claim 35**

20

Since claim 35 is the computer program product version of claim 16 with the similar elements as claim 16 and since Skillen cannot teach each element of claim 16, Skillen also cannot teach each element of claim 35, and therefore, a rejection of claim 35 under 35 U.S.C. § 102(b) is inappropriate.

**Claims 36**

25

Since dependent claim 36 depends on independent claim 35 and since Skillen cannot teach each element of claim 35, Skillen also cannot teach each element of claim 36, and therefore, a rejection of claim 36 under 35 U.S.C. § 102(b) is inappropriate.

**Claims 32-34**

**Claim 32**

To the extent the Examiner's language at page 3-5 of the Office Action can be understood, it appears that the Examiner has asserted the following correspondence between Skillen and claim 32:

Claim 32	<u>Skillen</u>
<p>A system for providing associated advertisements for search result items from an Internet search of an information repository, comprising:</p> <p style="padding-left: 40px;">a user/session manager means for maintaining and tracking <i>search result items</i> from user sessions, user queries, and advertisement requests;</p> <p style="padding-left: 40px;">a product database means for providing storage and retrieval for said associated advertisements;</p> <p style="padding-left: 40px;">a product matching manager means for analyzing said user sessions, said user queries, and said advertisement requests from said user/session manager and <i>matching</i> said associated advertisements from said product database corresponding to each of said <i>search result items</i>;</p> <p style="padding-left: 40px;">a request server means for displaying results from said search and displaying said associated advertisements from said product matching manager; and,</p> <p style="padding-left: 40px;">a product presentation manager means for referencing and retrieving said</p>	<p>-</p> <p><u>Skillen</u> does not teach this claim element.</p> <p>-</p> <p><u>Skillen</u> does not teach this claim element.</p> <p><u>Skillen</u> does not teach this claim element.</p> <p><u>Skillen</u> does not teach this claim element.</p>

<p>associated advertisements that correspond to each of said <i>search result items</i>, in said product database, and to formulate said associated advertisements into a list, and pass said list to said request server.</p>	
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In reviewing the cited portions of Skillen, however, it becomes apparent that Skillen has been generalized, and, in fact, does not support the position asserted by the Examiner. With regard to claim 32, Skillen fails to teach “a product matching manager means for

5 analyzing said user sessions, said user queries, and said advertisement requests from said user/session manager and *matching* said associated advertisements from said product database corresponding to each of said *search result items*”, as required by claim 32. Instead, Skillen teaches away from this claim element by teaching “[looking] for a match in the product database 42 [by] determining a logical product fit to the initial search argument”, where the

10 initial search argument is not the “*search result items*” required in claim 32. (See Skillen, page 9, lines 14-37 and page 10, lines 1-13.) Skillen teaches uses the same search argument for an Internet search for a search of a product database. (See Skillen, page 9, lines 14-37 and page 10, lines 1-13.) In contrast, claim 32 uses the results of an Internet search, the “*search result items*”, as inputs to a search of a repository of advertisements. Thus, Skillen cannot

15 teach this element of claim 32.

For similar reasons, Skillen cannot teach “a user/session manager means for maintaining and tracking *search result items* from user sessions, user queries, and advertisement requests”, cannot teach “a request server means for displaying results from said search and displaying said associated advertisements from said product matching manager”,

20 and cannot teach “a product presentation manager means for referencing and retrieving said associated advertisements that correspond to each of said *search result items*, in said product database, and to formulate said associated advertisements into a list, and pass said list to said request server”, as required by claim 32. It is therefore clear that Skillen cannot teach each

element of claim 32 and, therefore, a rejection of claim 32 under 35 U.S.C. § 102(b) is inappropriate.

### **Claim 33**

Since dependent claim 33 depends on independent claim 32 and since Skillen cannot  
5 teach each element of claim 32, Skillen also cannot teach each element of claim 17-33, and  
therefore, a rejection of claim 33 under 35 U.S.C. § 102(b) is inappropriate.

### **Claim 34**

Since claim 34 is the computer program product version of claim 32 with the similar  
elements as claim 32 and since Skillen cannot teach each element of claim 32, Skillen also  
10 cannot teach each element of claim 34, and therefore, a rejection of claim 34 under 35 U.S.C.  
§ 102(b) is inappropriate.

### **C. Whether claims 13, 14, 21, 30, and 37 are unpatentable under 35 U.S.C. § 103(a) as being obvious over Skillen**

15 Applicants respectfully traverses the obviousness rejection of claims 13, 14, 21, 30, and  
37 over Skillen, and submit that claims 13, 14, 21, 30, and 37 are not obvious over Skillen,  
and are patentable thereover. In support of this position, Applicants submit the following  
arguments:

#### **20 1. Legal Standards for Obviousness**

The following legal authorities set the general standards in support of Applicant's position  
of non obviousness, with emphasis added for added clarity:

- 25 • MPEP §2143.03, "All Claim Limitations Must Be Taught or Suggested: To establish  
prima facie obviousness of a claimed invention, **all the claim limitations must be taught  
or suggested by the prior art.** In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).  
"All words in a claim must be considered in judging the patentability of that claim  
against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA  
1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim  
30 depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.  
1988)."

- 5 MPEP §2143.01, "The Prior Art Must Suggest The Desirability Of The Claimed Invention: There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (**The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obvious was held improper.**). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).
- 10 • "**Obviousness cannot be established** by combining the teachings of the prior art to produce the claimed invention, **absent some teaching or suggestion** supporting the combination." In re Fine, 837 F.2d at 1075, 5 USPQ2d at 1598 (citing ACS Hosp. Sys. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)). **What a reference teaches** and whether it teaches toward or **away from the claimed invention** are questions of fact. See Raytheon Co. v. Roper Corp., 724 F.2d 951, 960-61, 220 USPQ 592, 599-600 (Fed. Cir. 1983), cert. denied, 469 U.S. 835, 83 L. Ed. 2d 69, 105 S. Ct. 127 (1984). "
- 20 • "When a rejection depends on a combination of prior art references, there must be **some teaching, suggestion, or motivation** to combine the references. See In re Geiger, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987)." **Obviousness can only be established by combining or modifying** the teachings of the prior art to produce the claimed invention **where there is some teaching, suggestion, or motivation** to do so

25 found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See MPEP 2143.01; In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).
- 30 • "With respect to core factual findings in a determination of patentability, however, the **Board cannot simply reach conclusions based on its own understanding or experience** -- or on its assessment of what would be basic knowledge or common sense. **Rather, the Board must point to some concrete evidence in the record** in support of

35 these findings." See In re Zurko, 258 F.3d 1379 (Fed. Cir. 2001).
- 40 • "We have noted that **evidence of a suggestion, teaching, or motivation to combine** may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg. v. SGS Imports Intern., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), although "the suggestion more often comes from the teachings of the pertinent references," Rouffet, 149 F.3d at 1355, 47 USPQ2d at 1456. The range of sources available, however, does not diminish the requirement for actual

evidence. That is, the showing must be clear and particular. See, e.g., C.R. Bard, 157 F.3d at 1352, 48 USPQ2d at 1232. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." E.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993) ("Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact."); In re Sichert, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977)." See In re Dembiczak, 175 F. 3d 994 (Fed. Cir. 1999).

- "To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." See In re Rouffet, 149, F.3d 1350 (Fed. Cir. 1998).

- The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references).

- If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

## **2. Application of the Obviousness Standard to the Present Invention**

By the Final Office Action dated December 3, 2003, the Examiner has rejected claims 13, 14, 21, 30, and 37 under 35 U.S.C. § 103(a) as being unpatentable over Skillen. In order to form a proper obviousness rejection of a claim under 35 U.S.C. § 103(a), a collection of references together must teach or suggest each element of the claim, including the relationships between the elements. If any element is not fully taught by the combined references, the rejection cannot be sustained.

Evaluating Skillen in this light, it is appropriate to examine the portions of Skillen that the Examiner has pointed to as teaching the claimed elements of the rejected claims.

### **Claim 13 and 14**

Since Skillen cannot teach each element of claim 1, Skillen can neither teach nor suggest each element of claim 1, and, therefore, a rejection of claim 1 under 35 U.S.C. § 103(a) would be inappropriate. Since claim 6 depends on claim 1 and since Skillen can neither teach nor suggest each element of claim 1, Skillen can neither teach nor suggest each element of claim 6 and, therefore, a rejection of claim 6 under 35 U.S.C. § 103(a) would also be inappropriate. Since claims 13 and 14 depend on claim 6 and since Skillen can neither teach nor suggest each element of claim 6, Skillen can neither teach nor suggest each element of claims 13 and 14, therefore, a rejection of claims 13 and 14 under 35 U.S.C. § 103(a) is inappropriate.

10        **Claim 21**

Since Skillen cannot teach each element of claim 16, Skillen can neither teach nor suggest each element of claim 16, and, therefore, a rejection of claim 16 under 35 U.S.C. § 103(a) would be inappropriate. Since claim 21 depends on claim 16 and since Skillen can neither teach nor suggest each element of claim 16, Skillen can neither teach nor suggest each element of claim 21 and, therefore, a rejection of claim 21 under 35 U.S.C. § 103(a) is inappropriate.

15        **Claim 30**

Since Skillen cannot teach each element of claim 26, Skillen can neither teach nor suggest each element of claim 26, and, therefore, a rejection of claim 26 under 35 U.S.C. § 103(a) would be inappropriate. Since claim 30 depends on claim 26 and since Skillen can neither teach nor suggest each element of claim 26, Skillen can neither teach nor suggest each element of claim 30 and, therefore, a rejection of claim 30 under 35 U.S.C. § 103(a) is inappropriate.

20        **Claim 37**

25        Since Skillen cannot teach each element of claim 36, Skillen can neither teach nor suggest each element of claim 36, and, therefore, a rejection of claim 36 under 35 U.S.C. § 103(a) would be inappropriate. Since claim 37 depends on claim 36 and since Skillen can neither teach nor suggest each element of claim 36, Skillen can neither teach nor suggest each



element of claim 37 and, therefore, a rejection of claim 37 under 35 U.S.C. § 103(a) is inappropriate.

**CONCLUSION**

All the claims presently on file in the present application are in condition for  
5 immediate allowance, and such action is respectfully requested. It is respectfully submitted  
that the application has now been brought into a condition where allowance of the case is  
proper. Reconsideration and issuance of a Notice of Allowance are respectfully solicited.

10

Date: April 5, 2004

Respectfully Submitted,



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## APPENDIX A

### CLAIMS ON APPEAL

- 5 1. A method of targeting at least one associated advertisement from an Internet search having access to an information repository by a user, comprising:
- identifying at least one search result item from a search result of said Internet search by said user;
- searching for said at least one associated advertisement within said repository using
- 10 said at least one search result item;
- identifying said at least one associated advertisement from said repository having at least one word that matches said at least one search result item; and
- correlating said at least one associated advertisement with said at least one search result item.
- 15
2. The method of claim 1 further comprising providing said at least one associated advertisement on demand by said user.
3. The method of claim 1 wherein said information repository is associated with an
- 20 Internet server.
5. The method of claim 1 further comprising displaying along with said at least one search result item a user-selectable icon containing a link to said at least one associated advertisement.
- 25
6. The method of claim 1 further comprising:
- designating said at least one search result item matched to said at least one associated advertisement for subsequent selection by a user.

7. The method of claim 6 further comprising first submitting a query to said information repository and obtaining said at least one search result item.
8. The method of claim 6 wherein designating said at least one search result item further  
5 comprises displaying a graphical user interface to said user.
9. The method of claim 6 wherein said at least one associated advertisement comprises at least one related product advertisement.
- 10 10. The method of claim 6 further comprising assigning a user identifier prior to matching said at least one search result item to said at least one associated advertisement.
11. The method of claim 6 further comprising formatting said at least one associated advertisement matched with said at least one search result item so designated, prior to  
15 displaying said at least one related product advertisement.
12. The method of claim 6 further comprising storing said at least one associated advertisement using a URL as an identifier for each of said at least one search result item.
- 20 13. The method of claim 6 further comprising performing an off-line batch process for each of said at least one search result item, wherein said batch process identifies said at least one associated advertisement for said at least one search result item.
14. The method of claim 6 further comprising providing a true/false designator to a user,  
25 wherein said designator indicates whether said at least one associated advertisement exists for said at least one search result item.
15. The method of claim 8 wherein said graphical user interface comprises a product icon.

16. A method for providing related advertisements for search result items from a search of an information repository, comprising:

matching said search result items to said related advertisements;

designating each of said search result items that have said related advertisements

5 matched therewith;

providing a corresponding graphical user interface for each of said search result items so designated for subsequent user selection;

searching and retrieving said related advertisements for one of said search result items when said corresponding graphical user interface is selected by a user; and,

10 formatting and displaying said related advertisements upon selection.

17. The method of claim 16 further comprising assigning an identifier for said user when said user submits a query to said information repository.

15 18. The method of claim 16 wherein said related advertisements comprise related product advertisements.

19. The method of claim 16 wherein said graphical user interface comprises a product icon.

20

20. The method of claim 16 further comprising storing said related advertisements using a URL as an identifier for each of said search result items.

21. The method of claim 16 further comprising performing an off-line batch process for  
25 each of said search result items, wherein said batch process identifies said related advertisements for said search result items.

22. A program storage device readable by a machine, tangibly embodying a program of instructions executable by the machine to perform the method steps for targeting at least one

associated advertisement from an Internet search having access to an information repository by a user, comprising:

identifying at least one search result item from a search result of said Internet search by said user;

5        searching for said at least one associated advertisement within said repository using said at least one search result item;

identifying said at least one associated advertisement from said repository having at least one a word that matches said at least one search result item; and

10        correlating said at least one associated advertisement with said at least one search result item.

23.    The program storage device of claim 22 further comprising providing said at least one associated advertisement on demand by said user.

15    25.    The program storage device of claim 22 further comprising displaying along with said at least one search result a user-selectable icon containing a link to said at least one associated advertisement.

20    26.    A program storage device readable by a machine, tangibly embodying a program of instructions executable by the machine to perform the method steps for targeting related advertisements to individual search result items from a search of an information repository, said method steps comprising:

matching said individual search result items to said related advertisements; and,

25        designating those of said individual search result items matched to said related advertisements for subsequent selection by a user.

27.    The program storage device of claim 26 further comprising the method step of first submitting a query to said information repository and obtaining said individual search result items.

28. The program storage device of claim 26 wherein designating said individual search result items further comprises displaying a graphical user interface to said user.

29. The program storage device of claim 26 further comprising the method step of storing  
5 said related advertisements using a URL as an identifier for each of said individual search result items.

30. The program storage device of claim 26 further comprising the method step of  
10 performing an off-line batch process for each of said individual search result items, wherein said batch process identifies said related advertisements for said search result items.

31. A program storage device readable by a machine, tangibly embodying a program of instructions executable by the machine to perform the method steps for providing related advertisements for search result items from a search of an information repository, comprising:  
15 matching said search result items to said related advertisements;  
designating each of said search result items that have said related advertisements matched therewith;  
providing a corresponding graphical user interface for each of said search result items so designated for subsequent user selection;  
20 searching and retrieving said related advertisements for one of said search result items when said corresponding graphical user interface is selected by a user; and,  
formatting and displaying said related advertisements upon selection.

32. A system for providing associated advertisements for search result items from an  
25 Internet search of an information repository, comprising:  
a user/session manager means for maintaining and tracking search result items from user sessions, user queries, and advertisement requests;  
a product database means for providing storage and retrieval for said associated advertisements;

a product matching manager means for analyzing said user sessions, said user queries, and said advertisement requests from said user/session manager and matching said associated advertisements from said product database corresponding to each of said search result items;

5 a request server means for displaying results from said search and displaying said associated advertisements from said product matching manager; and,

a product presentation manager means for referencing and retrieving said associated advertisements that correspond to each of said search result items, in said product database, and to formulate said associated advertisements into a list, and pass said list to said request server.

10

33. The system of claim 32 further comprising a search engine and a browser.

34. A computer program product for providing related advertisements for search result items from a search of an information repository, comprising:

15 a computer readable program code means for causing a computer to effect maintaining and tracking user sessions, user queries, and advertisement requests;

a computer readable program code means for causing a computer to effect providing storage and retrieval of said related advertisements;

20 a computer readable program code means for causing a computer to effect analyzing said search result items and matching said related advertisements corresponding to each of said search result items;

a computer readable program code means for causing a computer to effect displaying results from said search and displaying said related advertisements; and,

25 a computer readable program code means for causing a computer to effect referencing and retrieving said related advertisements corresponding to each of said search result items, formulating said related advertisements into a list, and presenting said list to a user.

35. A computer program product for selecting related advertisements for search result items from a search of an information repository, comprising:

a computer readable program code means for causing a computer to effect matching said search result items to said related advertisements;

a computer readable program code means for causing a computer to effect designating each of said search result items that have said related advertisements matched therewith;

5 a computer readable program code means for causing a computer to effect providing a corresponding graphical user interface for each of said search result items so designated for subsequent selection by a user;

a computer readable program code means for causing a computer to effect searching and retrieving said related advertisements for one of said search result items when said  
10 corresponding graphical user interface is selected by said user; and,

a computer readable program code means for causing a computer to effect formatting and displaying said related advertisements upon selection.

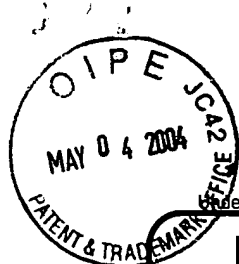
36. The computer program product of claim 35 further comprising

15 a computer readable program code means for causing a computer to effect submitting a query to said information repository; and,

a computer readable program code means for causing a computer to effect obtaining said search result items from said information repository.

20 37. The computer program product of claim 36 further comprising a computer readable program code means for causing a computer to effect assigning an identifier for said user when said query is submitted to said information repository.





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# FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$)**330.00**

Complete if Known

Application Number 09/583,516  
Filing Date 05/31/2000  
First Named Inventor Michael L. Emens  
Examiner Name Raquel Alvarez  
Art Unit 3622  
Attorney Docket No. AM9-99-0118

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GROUP 3600

## METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None

☒ Deposit Account:

Deposit Account Number 09-0441  
Deposit Account Name IBM Corporation

The Director is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☐ Credit any overpayments

☒ Charge any additional fee(s) or any underpayment of fee(s)

☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

## FEE CALCULATION

### 1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	

SUBTOTAL (1) (\$)**0-00**

### 2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

		Extra Claims		Fee from below		Fee Paid
Total Claims	<input type="text"/>	-20** =	<input type="text"/>	X	<input type="text"/>	<input type="text"/>
Independent Claims	<input type="text"/>	- 3** =	<input type="text"/>	X	<input type="text"/>	<input type="text"/>
Multiple Dependent					<input type="text"/>	<input type="text"/>

Large Entity		Small Entity		Fee Description
Fee Code	Fee (\$)	Fee Code	Fee (\$)	
1202	18	2202	9	Claims in excess of 20
1201	86	2201	43	Independent claims in excess of 3
1203	290	2203	145	Multiple dependent claim, if not paid
1204	86	2204	43	** Reissue independent claims over original patent
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$)**0-00**

\*\*or number previously paid, if greater; For Reissues, see above

## FEE CALCULATION (continued)

### 3. ADDITIONAL FEES

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for ex parte reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	330.
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify)

\*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$)**330.00**

## SUBMITTED BY

(Complete if applicable)

Name (Print/Type) Leonard T. Guzman  
Registration No. 46,308  
Telephone 408-927-3377  
Signature *Leonard T. Guzman*  
Date April 5, 2004

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3622

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# TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	09/583,516
Filing Date	5/31/2000
First Named Inventor	MICHAEL L. EMENS
Art Unit	3622
Examiner Name	RAQUEL ALVAREZ
Attorney Docket Number	AM9-99-0118

Total Number of Pages in This Submission

73

## ENCLOSURES (Check all that apply)

<input checked="" type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance communication to Group
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input checked="" type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Amendment/Reply	<input type="checkbox"/> Petition	<input checked="" type="checkbox"/> Appeal Communication to Group (Appeal Notice <u>Brief</u> Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Terminal Disclaimer	<input checked="" type="checkbox"/> Other Enclosure(s) (please Identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Request for Refund	RETURN POSTCARD, TRANSMITTAL FORM
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> CD, Number of CD(s) _____	
<input type="checkbox"/> Certified Copy of Priority Document(s)	Remarks	
<input type="checkbox"/> Response to Missing Parts/Incomplete Application		
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53		

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GROUP 3600

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	LEONARD T. GUZMAN (REGISTRATION NO. 46,308)
Signature	<i>Leonard T. Guzman</i>
Date	April 5, 2004

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Typed or printed name	LEONARD T. GUZMAN		
Signature	<i>Leonard T. Guzman</i>	Date	April 5, 2004

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